

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

Drawings

In section 1 of the Office Action, the Examiner objected to the drawings under 37 CFR 1.83(a). The Examiner stated:

The drawings must show every feature of the invention specified in the claims. Therefore, the wireless data link (claim 3); a coupled to the PDA rechargeable battery (claims 12 and 19); a cradled cellular telephone transceiver (claim 17); an expansion card as an input/output device including: a camera (claim 33), and a MP3 player (claim 34) must be shown or the feature(s) cancelled from the claims(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Figure 1 has been amended to depict a wireless link 123 which is also supported in the application at paragraph [0016] which has also been amended with reference numeral 123. Accordingly, no new matter has been added.

The Examiner's assertion that the drawings do not show the elements of claims 12 and 19 which recite that the expansion card connector is configured to couple to and provide power to a rechargeable battery pack is traversed. The rechargeable battery pack is depicted as element 354 interfacing with respect to receptacle 340 in FIG. 3 and battery pack 434 interfacing with a receptacle of cradle 420 in FIG. 4. The rechargeable battery pack 354 is described at paragraph 23 and battery pack 434 is similarly described at paragraph 25.

With regard to the mobile electronic device including a cellular telephone transceiver, it is inherent that handheld computers, such as handheld computers 130, 330, and 440, include cellular telephone transceiver, which the Examiner has asserted is not shown, devices for providing mobile communications including mobile data

transfer such as e-mail and web browsing as well as voice calls over cellular telephone networks. Accordingly, a handheld computer including a cellular telephone transceiver is generically shown in FIGs. 1, 3, and 4.

With regards to claim 33 and claim 34 which include a camera and an MP3 player as an expansion card input/output device, such devices are generically shown in block diagram 4 as SD card 430. Secure digital cards are well known to include input/output functionality and therefore be configured with devices such as cameras, MP3 players, and the like.

In section 3 of the Office Action, the Examiner rejected claims 12, 17, 19, 33, and 34 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated:

It is not clear without the drawings and their description how a whole device such a battery, a cellular phone transceiver, a camera or a MP3 player can fit into a card slot (Good examples of some of such devices having card like adapters plugged in card slots of PDA docking stations are Matsuzaki et al. – U.S. Patent 5,876,218 and Grimm et al. – U.S. Patent 5,907,815). Also it would be highly helpful by the applicant to provide direct references to specific models of such devices known in the art.

With regard to claims 12, 17, and 19, Applicants respectfully submit that the explanations provided with regard to the drawings above are sufficient to overcome the 35 U.S.C. § 112, second paragraph rejection. Further, with regard to claims 33 and 34, it is not recited in the claims that the entire input/output device, such as a camera or an MP3 player can fit into a card slot (as is asserted by the Examiner), however, it was well known at the time of the invention to provide for input/output devices having a card interface as those disclosed. For example, Applicants provide the following two references, an article dated June 27, 2000 entitled "SD Card Association" describing SD card based input/output devices like MP3 players and digital cameras, and a brochure entitled "Palm's Dual Expansion Architecture" which depict such devices in Figure 2 on page 7. The two references are provided in the attached supplemental information disclosure statement. The references both describe a plurality of

input/output devices which are configured as secure digital cards. Accordingly, Applicants respectfully submit that the subject matter cited in claims 33 and 34 are not indefinite, but were clearly well known in the art at the time of the invention and are thus represented in FIG. 4 as SD card 430.

Claim Rejections – 35 U.S.C. § 103

In section 5 of the Office Action, the Examiner rejected claims 1-39 (claims 12, 17, 19, 33, 34 as best understood by examiner under 35 U.S.C. 103(a) as being unpatentable over Hachiman et al. in view of Hawkins et al. The Examiner stated:

Hachiman et al. teach a docking station for a handheld computer, Figs. 1-17, comprising: a data connection configured to communicate data from the docking station 1 to the handheld computer 2 and from the docking station 2 to a personal computer 300 (inherently comprising as it is well known in the art a communication bus, and coupled to said communication bus a storage device, a memory, and a processor); and an expansion card 600 connector 57, Fig. 11, coupled to the docking station and configured to communicate data between an expansion card 600 and the docking station 1. Hachiman et al. teach furthermore said docking station having a wireless data link 64, Fig. 11, or a modem data link 500, Fig. 8, to communicate data to a communication network. Hachiman et al. does not teach said docking station being a synchronization docking station. Hawkins et al. teach a synchronization cradle 130 for a handheld computer, Fig. 1, comprising: a data connection configured to communicate data from the docking station 160 to the handheld computer 130 and from the docking station to a personal computer 113, wherein said docking station comprising a start synchronization button 125 (col. 3, lines 10-55). It would have been obvious to one skilled in the art at the time invention was made to employ a synchronization docking station as it is shown by Hawkins et al. in the device by Hachiman et al. in order to avoid including in the system a separate synchronization device.

Regarding to the claims 7, 14-15, 21-30 and 35: The functional recitations that the claimed hardware includes computer programs configured to perform certain tasks has been given patentable weight because it is narrative in form. In order to be given patentable weight a functional recitation must be expressed as a "means" for performing the special function, as set forth in 35 U.S.C. § 112, 6th

paragraph, and must be supported by recitation in the claim of sufficient structure to warrant the presence of the functional language. *In re Fuller*, 1929 C.D. 172; 388 O.G. 279. In view of the above examiner directs applicant's attention to the fact the neither the disclosure nor the drains of the instant application comprise any description or block diagrams or codes of any computer programs. Also it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In the Office Action, the Examiner rejected claims 1-39 under 35 U.S.C. § 103(a) as being unpatentable over Hachiman et al. in view of Hawkins et al. Applicants assert that the Hawkins et al. reference may not be used to preclude patentability in accordance with 35 U.S. C. § 103(c).

The present application and U.S. Patent No. 6,330,618 to Hawkins et al. were, at the time the invention of the present application was made, owned by Palm, Inc. or subject to an obligation of assignment to Palm, Inc.

The revised 35 U.S. C. § 103(c) "applies to all utility, design and plant patent applications filed on or after November 29, 1999." MPEP § 706.02(l)(1). The Hawkins et al. patent is assigned to Palm, Inc., and the present application is assigned to Palm, Inc., accordingly, the two references are commonly owned. See MPEP § 706.02(l)(2).

Because the Hawkins et al. reference may not be used to preclude patentability of the present application under 35 U.S. C. § 103(a), Applicants respectfully request that the Examiner withdraw the rejection of claims 1-39 based upon Hachiman et al. in view of Hawkins et al., and allow all claims.

Further, in section 5 of the Office Action, the Examiner rejected claims 11, 12, 17-19, 33, 34 under Hachiman et al. and LeFevre et al. The Examiner stated:

Hachiman et al. and LeFevre et al. disclose the claimed invention except for: a secure digital card (SD), or a multimedia card (MMC), or a battery, or a cellular phone

transceiver, or a camera, or a MP3 player being inserted into a card slot of the docking station (By Hachiman et al. card 600 is a memory card without specifying its kind). It would have been obvious matter of design choice to use said card slot to insert a secure digital card (SD), or a multimedia card (MMC), or a battery, or a cellular phone transceiver, or a camera, or an MP3 player, since applicant has not disclosed that a type of the inserted device solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any kind of available electronic device having appropriate size and electrical connection.

Regarding to the claims 35-39: The method steps are obviously necessitated by the device structure as Hachiman et al. and LeFevre et al. describe it.

Applicants respectfully submit that the present application was filed on May 2, 2001, and LeFevre et al. (U.S. Patent No. 6,429,625) was filed on May 18, 2001, and issued on August 6, 2002. Accordingly, LeFevre et al. is not prior art under 35 U.S.C. § 102. Therefore, the Examiner's rejection under 35 U.S.C. § 103(a) is improper. Accordingly, Applicants respectfully submit that claims 11, 12, 17-19, 33, 34, and 35-39 are therefore allowable.

* * *

After amending the claims as set forth above, claims 1-39 are now pending in this application.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

Application No.: 09/847,509

The Examiner is invited to contact the undersigned by telephone if it is felt that
a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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APPENDIX A

MARKED UP VERSION SHOWING CHANGES MADE

The following is a marked up version of a replacement paragraph as indicated in the Amendment and in accordance with 37 C.F.R. § 1.121. Applicants have used the convention underline to indicate added text and [square brackets] to indicate deleted text.

[0016] Synchronization cradle 120 is in communications with computer 110 via a data link 122. Data link 122 may be any of a variety of data links including, but not limited to, serial communication lines, parallel communication lines, USB communication lines, wireless connections 123 in which a cord such as cord 122 is not used and information is communicated via RF or optical methods. In an exemplary embodiment, synchronization cradle 120 includes a platform 124 configured to support a handheld computer 130 on platform 124. Further, synchronization cradle 124 includes an electrical connector 126 which couples to handheld computer 130 and facilitates communications between handheld computer 130 and computer 110. Further, synchronization cradle 120 includes a button 128 which may be utilized for initiating synchronization or transfer of data between handheld computer 130 and computer 110. Synchronization can also be initiated via keyboard 112 of computer 114. Further, in an alternative exemplary embodiment other buttons may be included on synchronization cradle 120. Such buttons may be utilized for exchanging data between handheld computer 130 and any of a variety of data storage devices and/or memory cards, or for other functions. For example, synchronization cradle 120 may include a plurality of expansion card slots 140 which are configured to accept a variety of expansion card devices such as, but not limited to, secure digital (SD) memory cards 142. Other types of expansion cards or memory devices which may be inserted into slots 140 include, but are not limited to, multimedia cards (MMCs). Further, in an exemplary embodiment, handheld computer 130 may also include a slot or receptacle for receiving an SD or MMC card 144 from which data may be used and/or transferred while the handheld computer is in synchronization cradle 120 or while handheld computer 130 is mobile.



Application No.: 09/847,509

APPENDIX B

MARKED UP VERSION SHOWING CHANGES MADE

The following are marked up versions of the replacement claims as indicated in the Amendment and in accordance with 37 C.F.R. § 1.121. Applicants have used the convention underline to indicate added text and [square brackets] to indicate deleted text.

21. A computer system, comprising:
 - a communications bus;
 - a storage device coupled to the communications bus;
 - a memory coupled to the communications bus;
 - a processor coupled to the communications bus; [and]
 - a synchronization cradle for a handheld computer, the synchronization cradle including at least one slot for accepting an expansion card and the synchronization cradle in communications with the communications bus; and
 - a program stored in the memory and running on the processor, the program configured to display to a user a listing of the contents of the expansion card.